

REMARKS

Status of Claims

Claims 1-3, 6, 7 and 10-17 remain pending. Claims 4, 5, 8, 9 and 18-30 are withdrawn. New claim 31 has been added.

Election/Restrictions

Applicant confirms the election with traverse made by telephone on March 3, 2008, in which applicant elected to prosecute Group I, Species A of Set I and Species X of Set II.

Claim Rejections Under 35 U.S.C. § 102

Claims 1, 3, 6, 10 and 15 are rejected under 35 U.S.C. § 102(b) as being anticipated by Prather (U.S. Patent No. 5,404,887). This rejection is respectfully traversed.

The Office Action of March 18, 2008 states that Fig. 14 of Prather illustrates surface contours 78, and that these surface contours are as claimed in independent claim 1 and associated dependent claims. Applicant respectfully disagrees with the examiner's interpretation of Prather with regard to Fig. 14.

Indeed, Prather as a whole is directed to a guide wire having a sleeve member formed from an extruded polymer. The sleeve member has an unsmooth exterior surface, such that when the sleeve is disposed on a guide wire, the guide wire is thereby provided with a rough exterior surface.

Figure 14 of Prather is not a departure from this sleeve-with-a-rough-exterior approach. Fig. 14 is intended to illustrate generally how a guide wire having a sleeve with a rough exterior, as taught throughout the reference, behaves within the interior of a lumen. But there is nothing in the Prather reference to suggest that the exterior

protrusions of the guide wire are not provided by a sleeve. To the contrary, the discussion of Fig. 14 specifically refers to a sleeve:

As can be clearly seen by comparing Figs. 13 and 14 the guide wire according to the present invention reduces the amount of surface area contact between the exterior of the guide wire and the guide wire lumen wall. In addition, the sleeve according to the invention may be extended over a greater length of the core wire than illustrated in the preferred embodiments. In fact, the sleeve member could extend substantially the entire length of the core member if desired. (Prather, Col. 8, ll. 50-59).

Claim 1 of the present invention is quite different from the disclosure of Prather. For example, Claim 1 recited “a section of the elongated core includes at least one of randomized and non-randomized tactile surface contours.” There is no “tactile surface contour” on a core in Prather. It is clear from the overall disclosure of Prather that only a sleeve having exterior roughness, and not a core with “tactile surface contours” on the core itself, as claimed, is shown in Prather.

Similarly, independent claim 16 provides a polymer coating that follows “randomized surface contours of the exterior surface of the distal core section.” Again, there is no such disclosure in the Prather reference.

Consequently, withdrawal of the §102(b) rejection of claims 1, 3, 6, 10 and 15 is respectfully requested.

Claim Rejections Under 35 U.S.C. § 103

Claims 2, 7 and 16-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Prather (U.S. Patent 5,404,887) as applied to claim 1, and further in view of McMahon (U.S. Patent No. 6,296,616). Claim 11 is rejected under 35 U.S.C. 103(a) as unpatentable over Prather as applied to claim 1, in further view of Mageoh (U.S. Patent 3,371,671). Claims 12 and 13 are rejected as being unpatentable over Prather as applied

to claim 1, and further in view of Richardson et al. (WO 01/036034). Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Prather as applied to claim 1, in view of Murayama et al. (US 2004/0039309). These rejections are respectfully traversed.

Applicant respectfully disagrees with the examiner's interpretation of Fig. 14 of the Prather reference and her rejections based on that interpretation. Applicant contends that Prather consistently teaches use of a sleeve, and does not disclose "at least one of randomized and non-randomized tactile surface contours" on the elongated core, as recited in claim 1, then the foregoing obviousness rejections are no longer appropriate. Withdrawal of the §103 rejections is therefore solicited.

Furthermore, with respect to independent claim 16, the McMahan reference does not disclose that "an exterior surface of the distal core section includes randomized tactile surface contours," as provided in claim 16. The exterior surface of the distal core section of McMahan is smooth and, as previously discussed, the distal core section of Prather is also smooth, with only a sleeve providing exterior roughness.

On this further ground, withdrawal of the §103 rejection with respect to independent claim 16 and its dependent claim 17 is also solicited.

New Claim 31

New independent claim 31 combines features of several claims: independent claim 16, and dependent claims 2, 12, 14 and 15. This unique combination is not taught or suggested in any of the cited references or any combination thereof. Consequently, allowance of claim 31 is respectfully requested.

Double Patenting

Claims 1-3, 6-7 and 10-15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 6 and 9-13 of

co-pending U.S. Application Serial No. 11/762,617. As this is a provisional rejection, applicant will delay a response on this issue until receiving indication of allowable subject matter in the present application.

Conclusion

In view of the foregoing, applicant respectfully submits that all claims are now in condition for allowance. Reexamination and reconsideration of the application are respectfully requested and allowance at an early date is solicited. Applicant invites the examiner to telephone the undersigned if there are any remaining questions.

Respectfully submitted,

FULWIDER PATTON LLP

By: /Paul Y. Feng/
Paul Y. Feng
Registration No. 35,510

PYF:SRH:jeb:njw

Howard Hughes Center
6060 Center Drive, Tenth Floor
Los Angeles, CA 90045
Telephone: (310) 824-5555
Facsimile: (310) 824-9696-
Customer No. 24201